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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/700,384 | 11/03/2003 | Nebojsa Curcic | FA1169USNA | 5811 |

23906 7590 06/28/2005

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4417 LANCASTER PIKE
WILMINGTON, DE 19805

EXAMINER

CAMERON, ERMA C

ART UNIT PAPER NUMBER

1762

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/700,384

Applicant(s)

CURCIC ET AL.

Examiner

Erma Cameron

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 3,4,6 and 9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) 1,2,5,7 and 8 is/are allowed.
- 6) ☒ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-8, drawn to a method of coating, classified in class 427, subclass 385.5.
 - II. Claim 9, drawn to an article, classified in class 428, subclass 411.1+.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the article can be made by a materially different process, such as one in which no foil is used.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. This application contains claims directed to the following patentably distinct species of the claimed invention:

A)

- a) where the curing proceeds prior to removal of the foil;
- b) where the curing proceeds after removal of the foil;
- c) where the curing proceeds prior to and after removal of the foil.

B)

- d) where the composition is thermally curable (claim 2);
- e) where the composition is curable by means of high-energy radiation (claim 3);
- f) where the composition is curable thermally and by high-energy radiation (claim 4).

C)

- g) where the binder has free-radically polymerizable bonds (claim 5);
- h) where the binder is crosslinkable by condensation and/or addition reactions (claim 6).

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Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

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6. During a telephone conversation with Hilmar Fricke on June 13, 2005 a provisional election was made WITHOUT traverse to prosecute the invention of Group 1 and a) in A), d) in B) and g) in C), claims 1-2, 5 and 7-8. Affirmation of this election must be made by applicant in replying to this Office action. Claims 3-4, 6 and 9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 112

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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a) Claim 8: it is not clear why the plural is used for “substrates” whereas claim 1 is in the singular.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1-2, 5 and 8 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Rattee et al (4315790).

‘790 teaches applying a composition to a fabric, the composition being comprised of a dye or pigment, a film-forming polymer, a crosslinking agent and a catalyst (see Abstract; 3:55-4:15). The composition is applied to a supporting substrate by screen printing (see Examples). The layer of transferable composition material on a substrate is pressed to the fabric while heating (an example of contact heating), and in one embodiment, the heating effects curing of the composition before removal of the substrate (6:65-7:11). The polymers include acrylics and others that would be polymerizable by free-radicals (5:41-68). The application of the coating may be considered original coating or decoration with an image.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rattee et al (4315790).

‘790 is applied here for the reasons given above.

‘790 does not teach that the composition is applied to a vehicle body, or body part or body fitting, but the fabric of ‘790 could be part of an automobile, such as fabric to be used in seats.

14. Claims 1-2, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over George (4061516) taken in view of Vogels et al (US 2002/0022575) or Rattee et al (4315790).

‘516 teaches applying a design, thermoplastic base coat (an acrylic) and an adhesive (another acrylic) to a carrier sheet such as Mylar, and adhering the coating material to a substrate thru heat and pressure from a roller (i.e. contact heating), after which the Mylar sheet is stripped off (1:55-3:15).

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'516 does not state that the coating materials are cured before application to the substrate, therefore, they are expected to be uncured state. The acrylics are olefinic double bonded materials that cure with free-radicals.

Regarding the substrate, the substrate of '516 may be an automotive part or fitting.

'516 does not teach screen printing the coating composition onto the backing foil.

'575 teaches that screen printing may be used to apply curable acrylic layers to support layers (see Abstract). '790 teaches that screen printing may be used to apply curable layers to a support layer (see Examples).

It would have been obvious to one of ordinary skill in the art to have used the '575 screen printing technique or the '790 screen printing technique in the '516 process, because both teach that screen printing is a conventional method of applying a curable material to a support layer.

15. Claims 1-2, 5 and 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO 95/02461 taken in view of Vogels et al (US2002/0011575) or Rattee et al (4315790).

'461 teaches applying metal particles, as well as a varnish such as polyurethane, to a transfer agent (plastic film). The transfer agent and a substrate are then brought together, before the varnish has had a chance to cure, and then the varnish is cured with heat or radiation. Then the substrate and transfer agent are separated.

Regarding the substrate, the substrate of '461 may be an automotive part or fitting.

'461 does not teach screen printing the coating composition onto the backing foil.

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'575 teaches that screen printing may be used to apply curable acrylic layers to support layers (see Abstract). 790 teaches that screen printing may be used to apply curable layers to a support layer (see Examples).

It would have been obvious to one of ordinary skill in the art to have used the '575 screen printing technique or the '790 screen printing technique in the '516 process, because both teach that screen printing is a conventional method of applying a curable material to a support

Double Patenting

16. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b)..

17. Claims 1-2 and 5-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 and 4-5 of copending Application No. 10/017132. Although the conflicting claims are not identical, they are not patentably distinct from each other because '132 teaches repair of a blemished area, and '384 teaches application of coatings in general, which would be inclusive of blemished areas.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

18. Claims 1-2 and 5-8 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 6-7 and 10 of copending Application No. 10/611731. Although the conflicting claims are not identical, they are not patentably distinct from each other because '384 teaches that the curing proceeds prior to or after removal of the foil or both prior to and after removal of the foil, whereas '731 teaches that the curing occurs only before the foil is removed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

19. Claims 1-2, 5 and 7-8 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/017132 which has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

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This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Both '132 and '384 teach substantially the same process, of applying a coating to a backing layer, transferring the coating to a substrate, curing the coating while the backing layer is still in place, and then removing the backing layer. '132 teaches that a blemished area is repaired, whereas '384 teaches application of a coating in general, but not specifically to a blemished area. '384 teaches curing with radiant heat, but not specifically the IR radiant heater of '132.

20. Claims 1-2, 5 and 7-8 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/611731 which has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Both '731 and '384 teach substantially the same process, of applying a coating to a backing layer, transferring the coating to a substrate, curing the coating while the backing layer is still in place, and then removing the backing layer. They are not patentably distinct from each other because '384 teaches that the curing proceeds prior to or after removal of the foil or both prior to and after removal of the foil, whereas '731 teaches that the curing occurs only before the foil is removed.

Conclusion

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erma Cameron whose telephone number is 571-272-1416. The examiner can normally be reached on 8:30-6:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Erma Cameron
ERMA CAMERON
PRIMARY EXAMINER

Erma Cameron
Primary Examiner
Art Unit 1762

June 23, 2005